UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,896	12/17/2003	Boris A. Maslov	76897-018CIP3	4040

61263 7590 08/07/2007

PROSKAUER ROSE LLP
1001 PENNSYLVANIA AVE, N.W.,
SUITE 400 SOUTH
WASHINGTON, DC 20004

EXAMINER	
COLON SANTANA, EDUARDO	
ART UNIT	PAPER NUMBER
2837	

MAIL DATE	DELIVERY MODE
08/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/736,896	MASLOV ET AL.	
	Examiner	Art Unit	
	Eduardo Colon Santana	2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7 and 10-38* is/are pending in the application.

4a) Of the above claim(s) *11-13 and 26-38* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7,10 and 14-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/2/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *Detailed Action*.

DETAILED ACTION

1. Applicant's amendment filed on 4/16/2007 have been received and entered in the case.

2. Applicant's responses with respect to the claims have been considered but they are not persuasive. See Response to Arguments below.

Election/Restrictions

3. Newly submitted claims 11-13 and 26-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims are directed to a specific vehicle, being a hybrid electric vehicle, in which an internal combustion engine works together with an electric motor being power by a battery. The original claims where directed to a car or other vehicle or an electric vehicle not requiring an internal combustion engine such as Hybrids.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-13 and 26-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 7, 10, 18, 21, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li U.S. Patent No. 6,278,216.

Referring to claims 7 and 10, Li discloses a vehicle motor for a motor vehicle having two wheels and one in-wheel electric motor (see

all figures and respective portions of the specifications). Although Li only discloses an in-wheel electric motor, a near-wheel, a direct-drive or a mechanically link is also well known in the art. Li further depicts a motor control system (figure 12) having a processor (MPU). However, Li does not disclose that the control system is dynamically adapted. It would have been obvious to one of ordinary skill in the art having a control system with a processor (MPU) as taught by Li to be dynamically adapted to any user inputs (i.e. speed, brake, etc.); any operating conditions (i.e. temperature) and any operating parameter (i.e. torque, current, voltage) for the purpose of forming a control scheme that performs efficiently with regards to its input commands. In addition it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 138.

As to claims 18 and 21, Li discloses in figure 12 a battery connected to the electric motor.

Referring to claims 24 and 25, Li discloses a controller (MPU) that is operatively connected to the electric motor. In addition, figure 12 depicts user inputs (i.e. brake level sensor, pedal sensor) that interface with the controller (MPU).

5. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being obvious over Li in view of Okuda et al. U.S. Patent No. 5,973,463.

Referring to claims 14-17, Li discloses a vehicle having two wheels and at least one electric motor including an in-wheel motor. However, Li does not describe a vehicle having at least four wheels. On the other hand, Okuda discloses an electric vehicle, having four wheels, disposed at a corner of the vehicle, wherein at least one electric motor is operatively connected to two or more wheels disposed at a front or a rear of the vehicle (see figures 1, items 10RR, 10RL, 10FR, 10FL, 12L and 12R). It would have been obvious to one ordinary skill in the art at the time of the invention to apply the principals taught by Li with a two wheel vehicle on a four wheel vehicle as shown by Okuda for the purpose/advantages of increasing reliability on a system that's in use on a daily basis, such as cars.

6. Claims 19-20 and 22-23 are rejected under 35 U.S.C. 103(a) as being obvious over Li in view of Stulbach U.S. Patent No. 6,082,476.

Referring to claims 19-20 and 22-23, Li discloses a battery (see figure 12), however does not describe that the battery is connected to a generator or that the generator is disposed in the vehicle. Nonetheless, Stulbach discloses a self-renewing electric vehicle (see figures 1 and 2), having electric motors (100 or 200) being power by batteries (1-3), wherein each battery is electrically connected to a generator (10-12) and the generator is disposed in the vehicle. It would have been obvious to one ordinary skill in the art at the time of the invention to use generators as taught by Stulbach within the teaching of Li, for the purpose/advantages that the generators would provide a regular charge of the battery, which would increase the

torque of the electric motor and at the same time provide the car with longer travel distances without the need to even recharge batteries.

Response to Arguments

7. Applicant's arguments filed on 4/16/2007 have been fully considered but they are not persuasive.

It is believed that the prior art of record reads on the claims 7 and 10 as previously presented.

In regards to applicants remarks that Li does not show, describe, teach or suggest a vehicle having a motor control scheme that can be dynamically adapted to form an adapted control scheme is not persuasive. Figure 12 of Li, clearly depicts a motor control circuit system, having a processor (MPU), receiving various input signals, which can obviously be dynamically adapt to various operating conditions.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., first motor control scheme to a second motor control scheme) are not recited in the rejected claims 7 or 10. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo Colon Santana whose telephone number is (571) 272-2060. The examiner can normally be reached on Monday thru Thursday 6:30am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lincoln Donovan can be reached on (571) 272-2800 X.37. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eduardo Colon Santana
Patent Examiner
Art Unit 2837

/ECS/
July 23, 2007

LINCOLN DONOVAN
SUPERVISORY PATENT EXAMINER